

ESTTA Tracking number: **ESTTA727379**

Filing date: **02/16/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Ohanae, Inc.
Granted to Date of previous extension	02/27/2016
Address	16133 Hillvale Ave. Monte Sereno, CA 95030 UNITED STATES

Attorney information	Daniel Kaylor, Esq. Law Office of Daniel Kaylor 16133 Hillvale Ave. Monte Sereno, CA 95030 UNITED STATES dkayloresq@gmail.com Phone:408 497-8347
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Applicant Information

Application No	86490313	Publication date	12/29/2015
Opposition Filing Date	02/16/2016	Opposition Period Ends	02/27/2016
Applicant	DIVX, LLC 4790 Eastgate Mall, Suite 200 San Diego, CA 92121 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: computer software for collecting, viewing, editing, organizing, modifying, bookmarking, transmission, storage, commenting on, and sharing of data and information; computer software for viewing, playing, downloading, transferring and sharing audio, video and other multimedia content among networked devices and devices that share a common communications protocol; and computer software for viewing, playing, downloading, transferring and sharing audio, video and other multimedia content to and among wireless devices; video encryption and decryption software; video encoding and decoding software; computer software for encoding, decoding, capturing, playing, viewing, downloading, transferring, commenting on, and sharing audio, video and other multimedia files; video encoding, decoding and transcoding software; digital rights management software; all of the foregoing in the field of creation, recording, secure distribution, sharing and playback of video content across a wide variety of devices including mobile and smart TVs

Class 042. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: providing a web site featuring temporary use of non-downloadable software for encryption, decryption, encoding, decoding, transcoding, capturing, playing, viewing, downloading, transferring, storing, sharing, commenting on, and distribution of audio, video and other multimedia files; providing a web site featuring temporary use of non-downloadable software for sending, receiving, storing, and managing encryption keys; software as a

service (SAAS) services featuring software for storing, managing and delivering digital rights management licenses; software as a service (SAAS) services featuring software for authorizing and managing playback of audio, video and other multimedia files on consumer electronics devices; providing a website that gives users the ability to review various print, photographic, graphic image, and audio and video content and to provide input, likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social networking; all of the foregoing in the field of creation, recording, secure distribution, sharing and playback of video content across a wide variety of devices including mobile and smart TVs

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3440230	Application Date	10/02/2007
Registration Date	06/03/2008	Foreign Priority Date	NONE
Word Mark	OHANAE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2007/04/30 First Use In Commerce: 2007/04/30 Computer programs for data management on portable storage devices		

Attachments	77294217#TMSN.png(bytes) TM OPPO2162016.pdf(4693001 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/daniel kaylor/
Name	Daniel Kaylor, Esq.
Date	02/16/2016

IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL
BOARD

IN THE MATTER OF TRADEMARK
APPLICATION SERIAL NO. 86/490313
PUBLISHED IN THE OFFICIAL GAZETTE ON
December 29, 2015
MARK: DIVX OHANA

OHANAE, INC.	
	Opposer,
v.	<u>OPPOSITION NO.</u>
DIVX OHANA,	
	Applicant.

NOTICE OF OPPOSITION

OHANAE, INC., INC., a California corporation with a place of business at 16133 Hillvale Ave., Monte Sereno, CA 95030 ("Opposer") believes that it will be damaged by the registration of the mark DIVX OHANA for the following goods and services:

Computer programs for data management on portable storage devices in International Class 9 covered by the above-identified application (the "Application") and hereby opposes the same.

The grounds for opposition are as follows:

Priority and Likelihood of Confusion Trademark Act section 2(d)
Dilution Trademark Act section 43(c)

1. Opposer is now and for many years past has, among other things, been

engaged in direct and indirect sales services, and interactive retail sales rendered by means of a global computer information network, all in the fields of security software and file transfers throughout the United States and the world. Its software encompasses a number of functions related to the safe transfer of software files on portable storage devices, notably: personal computers, smartphones, thumb drives and the like, including of course, smart tv applications. The files that it encrypts are not limited and include text files, video files and all other types of digital files that can be either transmitted over a global network or carried in devices in your pocket. Unrestricted and broad identifications of goods and services like OHANAE's are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). More complete descriptions of Opposer's file transfer activities can be found in Exhibits 1 through 6, attached hereto and made a part hereof.

2. Since long prior to December 24, 2014, the filing date of the intent-to-use application herein opposed, Opposer adopted, has used, and is using the mark OHANAE for its file security and encryption services. Opposer has prior use in interstate commerce of the OHANAE mark for its advanced computer file protection services and since the adoption and first use of the OHANAE mark as aforesaid Opposer has continuously used the OHANAE mark on and in connection with the production, advertising, promotion, distribution, and sale of its non-downloadable encryption and file protection software, and related goods in interstate commerce in the United States. Its goods and services are available

3. The OHANAE mark is now and ever since its first use as aforesaid has been applied to advertisements, and product literature for the aforesaid software and related goods. Products and materials so marked are now and for many years have been advertised and promoted, and widely shipped, distributed and sold in interstate commerce in the

United States. The OHANAE mark has come to be and is famous and of great value to Opposer, and in the mind of the trade and public, identifies Opposer's goods and distinguishes them from the goods and services of others.

4. Opposer is the owner in the United States of all right, title, and interest, in and to the following trademarks registered with the United States Patent and Trademark Office:

Trademark: OHANAE

Registration Number: 3440230

Full Goods & services: Computer programs for data management on portable storage devices.

5. The aforesaid registration is valid and subsisting, unrevoked and uncanceled. Furthermore, Opposer's rights to exclusive use of the mark OHANAE in connection with the goods described in Registration No. 3440230. Opposer owns said registration and the trademark covered therein, and all the business and goodwill symbolized thereby and associated therewith in the United States.

6. As a result of Opposer's long standing use and extensive advertising and promotion of the aforesaid goods and services, most importantly the excellence of the goods themselves, Opposer's Mark has attained an enviable reputations and goodwill that is exclusively associated with Opposer by the consuming public, signifying goods of the highest quality. As a result, Opposer's Mark and the goodwill symbolized by this mark are of inestimable value to Opposer.

7. Applicant seeks to register the mark DIVX OHANA for goods that are identical or closely related to Opposer's goods. However, Trademark Act Section 2(d)

bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterro Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Opposer's mark is a fanciful mark and is conceded to be a fanciful nonsense word. This does not strengthen Applicant's claim, but rather weakens it fatally as discussed below.

8. The Application was published in the December 29, 2015 issue of the Official Gazette. On January, the Board granted Opposer an extension of time to oppose the Application, until February 27, 2016.

9. Opposer has priority of use over Applicant, whose filing date is long

subsequent to Opposer's first use of its OHANAE mark.

10. Applicant's DIVX OHANA mark is confusingly similar, in appearance, sound and meaning to Opposer's Mark. Applicant's mark is intended for use on identical or closely related goods and, upon information and belief, will be marketed through the same or similar channels of trade.

11. Applicant's proposed mark gains no advantage by the addition of a house mark to an otherwise confusingly similar mark. This fails to obviate a likelihood of confusion under Section 2(d). *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and CACHET confusingly similar); TMEP §1207.01(b)(iii). It is likely that goods and/or services sold under these marks would be attributed to the same source. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007).

12. Given the close resemblance, meaning and commercial impression of the purported DIVX OHANA mark to Opposer's famous OHANAE mark, the use of the purported DIVX OHANA mark in connection with the advertising, offering for sale and sale of identical or closely related goods is likely to cause confusion or to cause mistake, or to deceive actual or potential purchasers into believing that Applicant's goods originate with or are in some way sponsored, licensed, approved or otherwise authorized or connected with Opposer.

13. Where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d

1039, 1049 (TTAB 2014) (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); TMEP §1207.01(b

14. Applicant's registration and use of the DIVX OHANA mark is also likely to dilute Opposer's famous OHANAE mark as a source designation for Opposer's goods.

15. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's purported trademark and would give to Applicant color of exclusive statutory rights to such designation in violation and derogation of the prior and superior rights of Opposer. Any faults or defects which might be found in Applicant's goods would reflect adversely upon and seriously injure the valuable reputation and goodwill of Opposer.

16. Finally, Applicant argued in its response to the Office action related to its mark that OHANAE is a fanciful mark. We agree. Fanciful marks are devices which have been invented for the sole purpose of functioning as a trademark and have no other meaning than acting as a mark. Fanciful marks are considered to be the strongest type of mark. Examples of fanciful marks are:

- EXXON
- KODAK
- XEROX

The Trademark Manual of Examining Procedure Section 1209.01 discusses the continuum of distinctiveness and strength that applies to trademarks.

- With regard to trademark significance, matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services. The degree of distinctiveness – or, on the other hand, descriptiveness – of a designation can be determined only by

considering it in relation to the specific goods or services. *Remington Products, Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, i.e., in connection with the goods).

- At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed by merely descriptive matter. Finally, generic terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. As stated in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), *quoting Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961), “[t]he name of a thing is in fact the ultimate in descriptiveness.”
- Fanciful, arbitrary, and suggestive marks, often referred to as “inherently distinctive” marks, are registrable on the Principal Register without proof of acquired distinctiveness. See **TMEP §1209.01(a)**.

When, as here, a mark is arbitrary or fanciful, it is awarded maximum protection. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1141 (9th Cir. 2002).

WHEREFORE, Opposer believes that it would be damaged by registration of Applicant's mark, DIVX OHANA, and prays that this opposition be sustained and registration of the mark DIVX OHANA be denied.

Dated: February 16, 2016

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "Daniel Kaylor", with a stylized flourish at the end.

Daniel Kaylor
Law Office of Daniel Kaylor
Attorney for Opposer

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(650) 308-9119
janice@ohanae.com

Ohanae Announces Ohanae for Salesforce on the Salesforce AppExchange, the World's Leading Enterprise Apps Marketplace

Ohanae empowers companies to share files securely
with anyone in a whole new way

San Francisco, Jan 28, 2016– Ohanae; today announced it has launched *Ohanae for Salesforce* on the Salesforce AppExchange, empowering businesses to connect with customers, partners and employees in a whole new way. Ohanae® protects passwords and data from any type of file, on all popular devices and in the cloud, and provides the ability to securely share that with anyone.

Built on the Salesforce App Cloud Platform, the social, mobile, and cloud customer platform to transform sales, service and marketing, Ohanae for Salesforce is now available on the AppExchange at [AppExchange.com](https://appexchange.com) (Salesforce Lightning Ready and compatible with Salesforce1 Mobile App).

The File Security Problem

Encryption of data is an essential security best practice. However many organizations and individuals fail to encrypt email attachments, files stored behind their corporate firewall, files stored on employees' laptop/mobile devices, or in the cloud.

CXOs and IT administrators understand the benefits of encrypting content: protecting sensitive or confidential information; protecting their organizations against data breaches; satisfying regulatory obligations; as well as protecting against the threat of legal liability. When moving their data to the cloud, Ohanae prevents third-party control over critical data resources as well as insider threats.

The trend toward increasing use of employee-owned mobile devices, mobile apps and cloud based applications is making data encryption more important than ever,” said Greg Hauw, founder and CEO, Ohanae. “A significant portion of application-to-human content, such as sales quotations, business proposals or agreements are sent unencrypted. The main reason for this is that the majority of users do not have access to manual encryption capabilities.”

“Companies are looking to transform the way they connect with customers, partners and employees to thrive in the age of the customer,” said Todd Surdey, SVP, ISV Sales, Salesforce. “By leveraging the power of the Salesforce platform, Ohanae provides customers with an exciting new way to protect and share data.”

Ohanae for Salesforce Key Features

Ohanae is a secure file sharing platform for enterprise social networks (Salesforce Chatter), file sync & share (Salesforce Files, OneDrive, Google Drive, Dropbox, Box), and email attachments, making private sharing of files and passwords safer and faster.

- The service manages policies and document-specific keys to authorized parties, both internal and external to the organization.
- Users can share any file with others and be confident that the recipient will be able to use it on all popular devices (iOS, Android, Universal Windows Platform App, Windows Desktop and Mac OS) installed with the Ohanae sharing app.
- Offers logical role-based access control based on Salesforce Identity with additional universal rights management features – restricted access, limited-time access, document tracking and revocation (Spring '16 release).

About Salesforce AppExchange

Salesforce AppExchange is the world’s leading enterprise apps marketplace empowering companies to sell, service, market and engage with the Internet of Customers. With more than 2,800 partner apps and more than 3 million customer installs, it is the most comprehensive source of social, mobile and connected cloud apps for business.

About Ohanae

California-based Ohanae empowers companies to share files securely with anyone in a whole new way. Unlike lesser solutions, Ohanae takes a two-pronged approach to secure both your passwords and files with zero knowledge encryption. Ohanae is unique because it allows security to *travel with* shared files. This gives organizations full visibility and control over all communications. Ohanae is fully built-on the Salesforce App Cloud. It features not only logical, role-based, access control based on Salesforce Identity, but also universal rights management features such as: restricted access, limited-time access, document tracking and remote revocation. Ohanae is the secure file sharing platform for enterprise social networking, file syncing & sharing. It makes the sharing of files and passwords safer, faster, and more private. Ohanae allows users to easily create, share, and keep files in the cloud, while permitting a secure and familiar access from any device. The Ohanae solution is easy to install and use without any disruption to normal workflows. Users can download the Salesforce managed package from AppExchange and the Ohanae sharing app from all the popular app stores. It's easy, it's powerful, and it's here, now!

Ohanae is the federally registered trademark of Ohanae, Inc.

Salesforce, Salesforce1, AppExchange, App Cloud and others are among the trademarks of salesforce.com, Inc.

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Secure File Sharing in a Whole New Way

Empowers companies to share
files securely with anyone

Encryption of data is an essential security best practice. Despite that fact, many organizations and individuals fail to encrypt email attachments, files stored behind their corporate firewall, files stored on employees' laptop/mobile devices, and files in the cloud.

CXOs and IT administrators understand the benefits of encrypting content: protecting sensitive or confidential information; protecting their organizations against data breaches; satisfying regulatory obligations; as well as protecting against the threat of legal liability. When moving their data to the cloud, Ohanae prevents third party control over critical data resources as well as insider threats.

The trend toward increasing use of employee-owned mobile devices, mobile apps, and cloud based applications is making the problem significantly worse. A significant portion of application-to-human content, such as sales quotations, business proposals, or agreements are sent unencrypted. The main reason for this is that the majority of users do not have access to manual encryption capabilities.

Organizations that encrypt content can create new business opportunities and a competitive differentiation that can contribute significantly to their bottom line and provide new ways of customer success.

Ohanae secures file sharing service for enterprise social networking, file synchronization & sharing, and email attachments, to make the sharing of files and passwords safer, faster, and more private.

Ohanae protects passwords and data from any type of file, on all popular devices and in the cloud, and securely shares that with anyone

Ohanae is unique because it allows security to travel with shared files. This gives organizations full visibility and control over all communications.

Ohanae never sees the data that you protect! The service only manages your policies and document-specific keys to authorized parties, both internal and external to your organization.

Users can share any files with others and be confident that the recipient will be able to use it on all popular devices (iOS, Android, Universal Windows Platform, Windows Desktop, and Mac) installed with the Ohanae sharing app.

Ohanae is available as a Software as a Service solution in the cloud hosted in Microsoft Azure.



Are your files at risk?

Ohanae for Salesforce

salesforce

The Secure File Sharing Platform for Chatter and Salesforce Files

Ohanae delivers secure file sharing in a whole new way. Ohanae secures file sharing service for enterprise social networking, file synchronization & sharing, email attachments, to make the sharing of files and passwords safer, faster, and more private.

- Ohanae allows users to easily create, share, and keep files in the cloud, while permitting secure and simple access from any devices.
- Unlike anyone else Ohanae takes a two-prong approach to secure both your passwords and files through zero knowledge encryption. Ohanae is unique because it allows security to travel with shared files to give organizations full visibility and control.
- The Ohanae solution is easy to install and use without any disruption to your normal workflows, users can download the Ohanae sharing app from the popular app stores. It's easy, it's powerful, and it's here!

Ohanae secures your files and passwords on any devices running iOS, Android, Windows, Mac OS, and in the cloud without requiring storage of any associated credentials.

In cases of secure file sharing, files are encrypted using unique encryption keys which are associated with specific recipients. This allows other Ohanae users to receive encrypted files from you without their knowing any of your critical security data, while maintaining the same level of data security.

For private files in Salesforce Files, Ohanae transparently encrypts files using a highly secure key that is generated on each use and not stored on the device or in the cloud. This encryption prevents access to documents by unauthorized users who might compromise your Salesforce account.

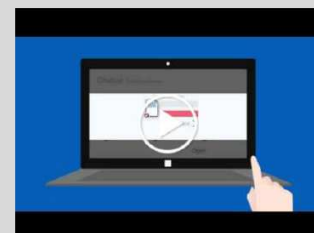
The password management function ensures that your Salesforce credentials are unique. These unique, highly secure passwords are not stored on the device nor in the cloud, they are dynamically created and then erased locally from your desktop or mobile devices.

Full-fledged logging in compliance with government regulations. Ohanae monitors your private and shared files uploaded/synced to the Salesforce multi-tenant cloud.

** Spring '16 release includes: logical role-based access control based on Salesforce Identity with additional universal rights management features – restricted access (authentication required), limited-time access, document tracking and revocation.

Secure File Sharing in a Whole New Way

Secure Document Collaboration



Cloud Privacy Protection



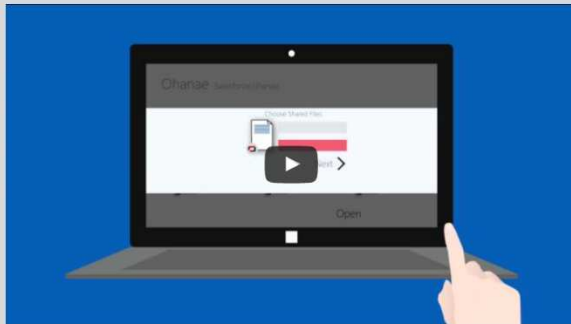
Cloud Compliance Policy



Secure Multi-Cloud Storage



For additional information, visit the [Salesforce AppExchange](#) site.



Download



Password Protection

Data Protection

Cloud Compliance

Ohanae Secure Document Collaboration for Enterprise Social, File Sync and Share makes sharing of data and credentials safer, faster and more private.

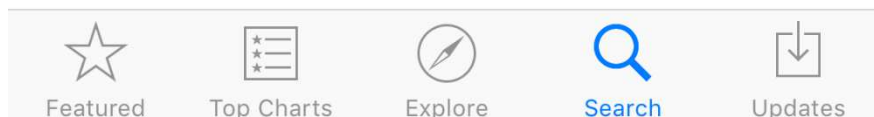
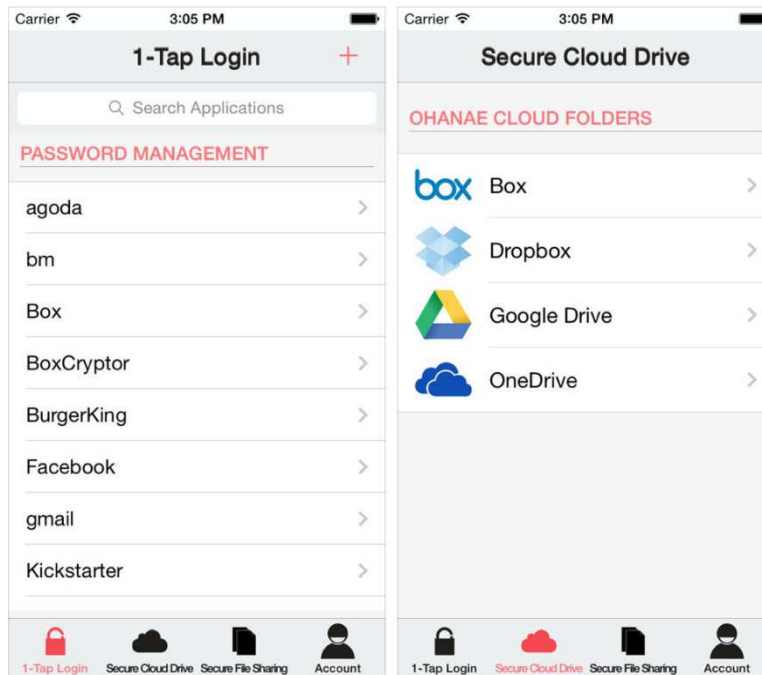
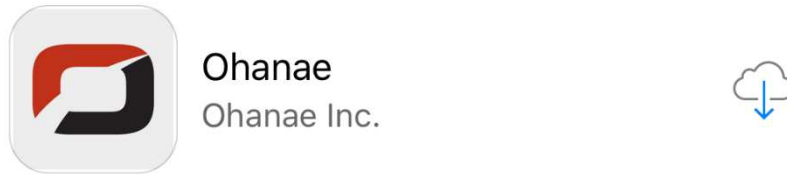
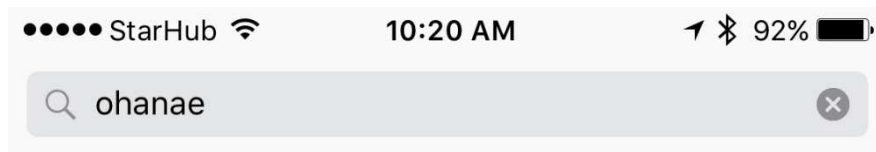


Exhibit 4 – App Store



Ohanae

Ohanae

Everyone

UNINSTALL

OPEN

Designed for phones



Downloads



10



Tools



Similar

Ohanae delivers secure file sharing in a whole new way



WHAT'S NEW

Updates in 1.4.38:

- Android Marshmallow Bug fixes.

Updates in 1.4.10:

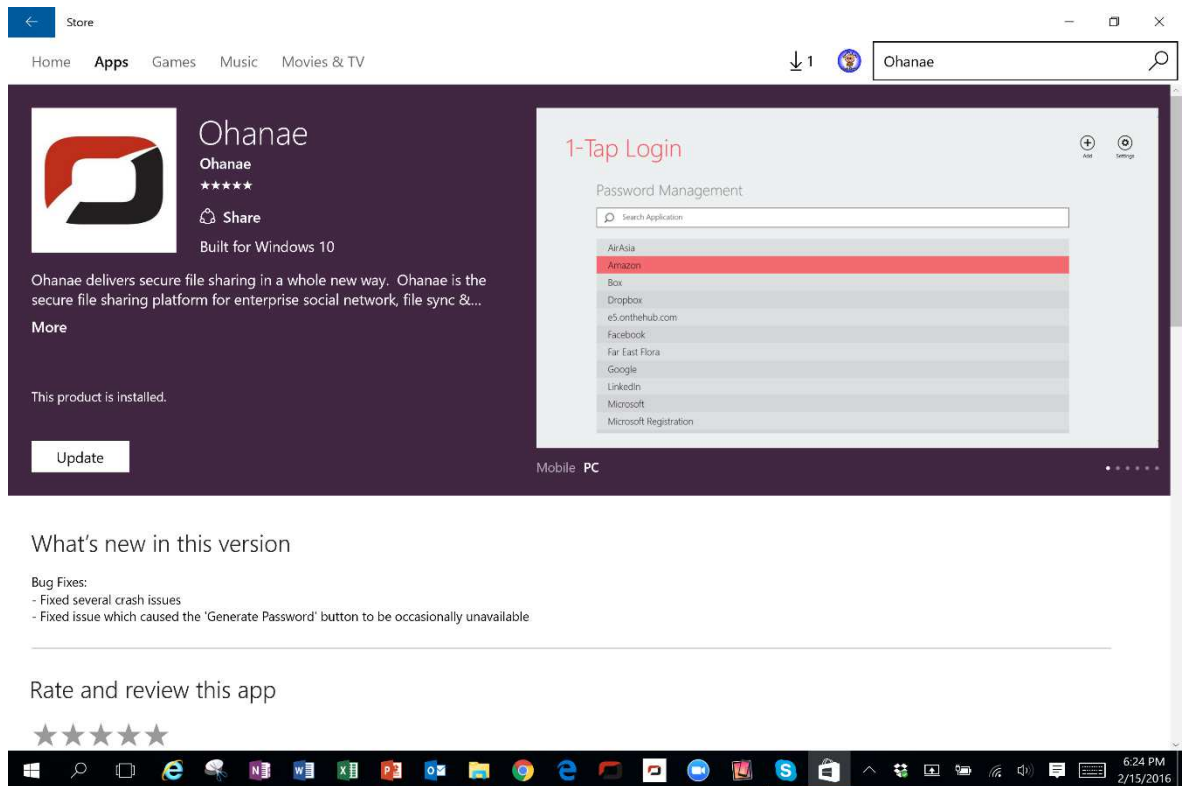
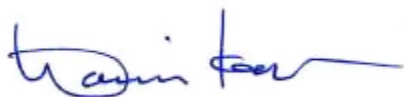


Exhibit 6 – Windows Store

CERTIFICATE OF SERVICE

I, Daniel Kaylor, attorney for Opposer, Ohanae, Inc., hereby affirm under the penalties of perjury, that on February 16, 2016, I caused a true and correct copy of the foregoing Notice of Opposition to be served via first class mail, postage prepaid, upon Applicant:

DIVX, LLC
c/o John M. Kim
IP Legal Advisors, P.C. Suite 220 445
Eastgate Mall San Diego, CA 92121



Daniel Kaylor